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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,362	12/11/2001	Masaki Kyojima	J355-037 US	1127
21706	7590	03/25/2005	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			PHILLIPS, HASSAN A	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/014,362

Applicant(s)

KYOJIMA ET AL.

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☒ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on January 11, 2001. It is noted, however, that applicant has not filed a certified copy of the P2001-3603 application as required by 35 U.S.C. 119(b).

### *Specification*

2. The disclosure is objected to because of the following informalities:

- a) The Examiner feels the word "sever" in the title should be "server".
- b) The "justified" format of the disclosure makes reading of the specification difficult (i.e. page 1, line14). The Examiner suggests using a different type of format for the disclosure.

Appropriate correction is required.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 13-21, are rejected under 35 U.S.C. 102(e) as being anticipated by Uskela, U.S. Patent 6,721,886.

6. In considering claims 1 and 4, Uskela teaches a server that provides services to clients connected to the server via a network, the server comprising: a public-key storage unit for storing public keys assigned to each service provided by the server, (col. 5, lines 6-16); a challenge generator for generating a challenge to be sent from the server to the client after the server receives a request for a service from the client, (col. 5, lines 20-32); ~~an access privilege verifier for verifying, using a corresponding public~~ key, whether a prescribed relationship exists between the challenge transmitted to the client and a response to that challenge received from the client, (col. 5, lines 32-34); and a controlling unit, while authenticating access privilege of the client for a service provided by the server, for transmitting the challenge generated by the challenge generator to the client, (col. 5, lines 25-32); for receiving the response to that challenge

returned from the client, (col. 5, lines 32-34); for verifying, with an access privilege verifier using a public key assigned to the service and stored in the public-key storage unit, whether a prescribed relationship exists between the challenge and the response, (col. 5, lines 32-34); and for providing the service to the client only when the access privilege verifier successfully verifies the relationship, (col. 5, lines 34-36).

7. In considering claims 2, 5, and 20, Uskela teaches a client that requests services from a server connected to the client via a network, the client comprising: a unique operation executor for executing a unique operation assigned to the client, (col. 5, lines 20-32); an access privilege proving data storage unit for storing access privilege proving data created from a private key corresponding to a public key assigned to the requested service and the result of the unique operation, (col. 5, lines 20-32); a response generator for generating a response to a challenge received from the server by executing a prescribed calculation using the result of the unique operation and the access privilege proving data, (col. 5, lines 20-32); and a controlling unit, while proving to the server that the client owns the access privilege for the service provided by the server, for receiving the challenge from the server, (col. 5, lines 20-32); for generating, with the response generator, the response from (a) the challenge, (b) the result of the unique operation executed by the unique operation executor, and (c) the access privilege proving data stored in the access privilege proving data storage unit, (col. 5, lines 20-32); and for transmitting the created response to the server, (col. 5, lines 20-32).

8. In considering claims 3, 6, and 21, Uskela teaches a client that requests services from a server connected the client via a network, comprising: a portable device connector for connecting to a portable device provided with a unique operation generator for executing unique operations, (col. 3, lines 31-56); an access privilege proving data storage unit for storing access privilege proving data created from a private key corresponding to a public key assigned to the requested service and the result of the unique operation assigned to the portable device, (col. 5, lines 20-32); a response generator for generating a response to a challenge received from the server by executing a prescribed calculation using the result of the unique operation and the access privilege proving data, (col. 5, lines 20-32); and a controlling unit, while proving to the server that the client owns the access privilege for the service provided by the server, for receiving the challenge from the server, (col. 5, lines 20-32); for generating, with the response generator, the response from (a) the challenge, (b) the result of the unique operation executed by the unique operation executor housed in the portable device connected to the portable device connector, and (c) the access privilege proving data stored in the access privilege proving data storage unit, (col. 5, lines 20-32); and for transmitting the created response to the server, (col. 5, lines 20-32).

9. In considering claims 7 and 8, Uskela teaches the access privilege proving data storage unit included in the portable device connected to the portable device connector, (col. 5, lines 20-32).

10. In considering claim 13, Uskela teaches a server that provides services to clients connected to the server via a network, the server comprising: a script interpreter for interpreting script designed to control the contents of services that the server provides to clients and for controlling the operations of the server, (col. 4, lines 46-55); and a privilege authenticator for authenticating access privileges of the client when called by the script interpreter, (col. 3, line 63 through col. 4, line 15).

11. In considering claims 14 and 15, Uskela teaches a challenge generator for generating a challenge to be sent from the server to the client, (col. 5, lines 20-32); and an access privilege verifier that uses a public key to verify a prescribed relationship between the challenge transmitted to the client and a response to that challenge returned from the client, (col. 5, lines 20-36); and the privilege authenticator receives a public key for authenticating privileges of the client when called by the script interpreter, transmits the challenge generated by the challenge generator to the client, receives a response to the challenge sent by the client, and verifies, using the received public key, ~~access privileges of the client by means of the access privilege verifier,~~ (col. 5, lines 20-36).

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12. In considering claims 16 and 18, Uskela teaches a method executed in a server for providing services from the server to clients connected to the server via a network after verifying the access privileges of the clients for the services, public keys

being assigned in advance to respective services provided by the server, the method comprising the steps of: generating a challenge when a request for a service is received from a client and transmitting the challenge to the client, (col. 5, lines 20-32); receiving a response to the challenge returned from the client, (col. 5, lines 20-32); verifying that a prescribed relationship exists between the challenge sent to the client and the response received from the client using the public key assigned to the requested service, (col. 5, lines 32-34); and providing the requested service to the client only when the prescribed relationship exists, (col. 5, lines 34-36).

13. In considering claims 17 and 19, Uskela teaches a method executed in a client for proving its access privilege for a server when requesting a service from a server connected to the client via a network, the client being in advance assigned with a unique operation, the requested service being in advance assigned with a public key, the client in advance receiving access privilege proving data for expressing the access privilege of the client for the service, the access privilege proving data being created from a private key corresponding to a public key assigned to the service and the result of a unique operation assigned to the client, the method comprising the steps of: receiving a challenge from the server, (col. 5, lines 20-32); executing the unique operation assigned thereto, (col. 5, lines 20-32); generating a response based on the challenge received from the server, the result of the unique operation, and the access privilege proving data, (col. 5, lines 20-32); and transmitting the response to the server, (col. 5, lines 20-32).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 9-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Uskela in view of Brown, U.S. Patent 6,487,667.

16. In considering claims 9-12, although the teachings of Uskela disclose substantial features of the claimed invention, they fail to explicitly teach the server being a web server.

Nevertheless, web servers were well known in the art at the time of the present invention. In a similar field of endeavor, Brown teaches a challenge-response technique that utilizes keys corresponding to web servers in granting access to the web servers, (col. 3, lines 29-65).

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the present invention to modify the teachings of Uskela to show the server being a web server, and the public keys stored in the public-key storage unit being assigned to individual web pages, or groups of web pages provided to the clients. This would have provided a reliable means for authenticating a client before allowing the client to

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view individual web pages, or groups of web pages, Uskela, col. 1, line 5 through col. 2, line 16.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wang et al., U.S. Patent 6,085,249, discloses a method and apparatus for transferring data from a web server in response to authentication information.

Choi et al. WO 01/01644, discloses an apparatus for securing information transmitted between a mobile device and a web server.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/  
3/17/05



**SALEH NAJJAR**  
**PRIMARY EXAMINER**

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